REMARKS

Favorable reconsideration in view of the previous amendments and following remarks is respectfully requested.

Claims 1, 2 and 4-16 are pending. Claim 14 has been withdrawn. Claims 1, 2, 4-13, 15 and 16 read on the elected embodiment. By this Amendment, claim 3 is canceled and claims 1, 8, 9 and 15 are amended.

The Office Action rejects claims 8 and 13 under 35 U.S.C. §102(e) over U.S. Patent Application Publication No. 2003/0005097 to Barnard et al.; rejects claims 1-6, 9-12, 15 and 16 under 35 U.S.C. §103(a) over Barnard in view of U.S. Patent No. 6,868,509 to Gale et al. and rejects claim 7 under 35 U.S.C. §103(a) over Barnard and Gale and further in view of U.S. Patent No. 6,195,514 to Machida. These rejections are respectfully traversed.

Independent claim 1 recites, in combination with other claimed features, when communications with a target printing device connected to a network fail, judging whether the IP address of the printing device has been changed or the printing device is powered off. A change in an IP address of the printing device is detected when it is judged that the IP address of the printing device has been changed and after the change in the IP address is detected, searching for a printing device over a network using information specific to the printing device.

In the rejection of dependent claim 3, the Office Action refers to paragraph [0014] for Barnard as disclosing the feature of judging whether the IP address of the printing device has been changed or the printing device is powered off. Paragraph [0014] of Barnard, relied upon by the Examiner throughout the Office Action, is reproduced below.

> By virtue of the foregoing, print queues are created and configured upon detection of a printing device. In addition, changes in printing device addresses or print queue identification information are updated in the corresponding print queue configurations, and network workstations are notified of the changes. Accordingly, tedious and time consuming tasks involved in the management of network printing devices are reduced.

However, there is no portion of paragraph [0014] of Bernard that relates to the printing device powered off. In the event that the Examiner continues to assert this rejection, Applicant respectfully requests that the Examiner indicate with particularity where this feature is disclosed so that Applicant can respond to the rejection.

Independent claim 8 recites a printing device comprising a detector detecting a change in an IP address, a recorder records a past IP address as specific information when the change in the IP address has been made. A new IP address is stored concurrently with the past IP address. A responder retrieves the recorded past IP address upon an inquiry from an external device and making a response.

As disclosed in Applicant's as-filed specification at paragraph [0039], printer specific information memory 505 within printer 100 holds printer specific information such as its former IP address, etc. The former IP address of the printer stored in printer specific information memory 505 in the printer is collated with the contents of printer specific information memory 605 in the PC to allow for secure matching.

In paragraph [0067], Barnard discloses that the IP address reflects either the previous IP address or the new IP address. Barnard does not disclose a new IP address and the past IP address being stored concurrently. Thus, independent claim 8 is distinguishable over Barnard. Furthermore, the Office Action asserts that Barnard discloses the features of independent claim 8 at paragraphs [0012] and [0014] of Barnard. However, paragraph [0014], reproduced above, indicates that

print queues are created and configured upon detection of a printing device. Changes in printing device addresses or print queue identification information are updated in the corresponding print queue configurations. Thus, paragraph [0014] of Barnard relates to print queues. It does not relate to a printing device including these features. As disclosed in Fig. 9 of Barnard, print queues 61 are part of the network management device 20. Printers 17 and 18 are separate devices from the print queue. As noted in the Examiner's Response to Arguments on page 9 of the Office Action, paragraph [0014] does refer to a "change in printing device addresses." However, "printing device addresses" are also not printers as recited in claim 8. Thus, claim 8 is distinguishable over Barnard.

As discussed in MPEP § 2111.02, any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. In the Advisory Action, the Examiner cites *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951), which states that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure and where the body of the claim does not depend on the preamble for completeness but instead, the process steps or structural limitations are able to stand alone. Applicant notes that in *Kropa,* the preamble of an "abrasive article" was deemed essential. Similarly, Applicant's recitation of a "printing device" is essential and not merely an intended use of the structure.

Gale and Machida do not overcome the deficiencies of Barnard noted above.

The dependent claims are allowable for at least the reasons discussed above as well as for the individual features they recite.
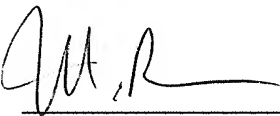
Early and favorable action with respect to this application is respectfully requested.

Should the Examiner have any questions regarding this Amendment or the application in general, he is invited to contact the undersigned at the telephone number provided below.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: <u>April 15, 2009</u>   By: _____

Michael Britton
Registration No. 47260

P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620